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PATENT

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re application of : Gene W. Zdenek, et al.
U.S. Serial No. : 09/863,006
Filed : May 22, 2001
For : SCLERAL EXPANSION DEVICE HAVING DUCK BILL
Group No. : 3738
Examiner : William H. Matthews

MAIL STOP APPEAL BRIEF - PATENTS

Commissioner for Patents
P.O. Box 1450
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2. Substitute Appellant's Brief on Appeal; and
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Sir:

SUBSTITUTE APPELLANTS' BRIEF ON APPEAL

This Substitute Brief is submitted in response to the Notice of Non-Compliance mailed January 3, 2005 for the application identified above. A check in the amount of \$440.00 was previously submitted for the Appeal Brief filing fee (\$330.00) and one-month extension fee (\$110.00). Please charge any additional necessary fees to Deposit Account No. 50-0208.

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REAL PARTY IN INTEREST

The real party in interest for this appeal is the assignee of the application, RAS HOLDING CORP., and related entity PRESBY CORP.

RELATED APPEALS AND INTERFERENCES

There are no appeals or interferences related to the present application.

STATUS OF CLAIMS

Claims 1–20 are pending in the present application. Claims 4, 7–9, 12, 16 and 19 have withdrawn from consideration by the Examiner following a restriction requirement, but have not been canceled. Claims 1–3 and 5–6 were rejected under 35 U.S.C. § 102(b) as being anticipated by U.S. Patent No. 5,879,319 to *Pynson et al.* Claims 10–11, 13–15, 17–18 and 20 were rejected under 35 U.S.C. § 103(a) as being obvious over U.S. Patent No. RE 35,390 to *Smith* in view of U.S. Patent No. 5,370,607 to *Memmen*. The rejection of claims 1–3, 5–6, 10–11, 13–15, 17–18 and 20 is appealed.

STATUS OF AMENDMENTS

An amendment to claims 3, 15 and 20 for clarity, to correct typographical and grammatical errors therein, was submitted concurrently with Appellants' Brief on Appeal.. Claim 3 was amended to recite “. . . wherein said ~~central body portion~~ prosthesis tapers steeply from a thickness of said central body portion to a thickness of said at least one end portion . . .,” for clarity and logical consistency. Claim 15 was amended to recite “. . . wherein a portion of said prosthesis ~~including a~~

region where said central portion ~~as~~ and said at least one end portion join tapers steeply . . .,” also for clarity. Claim 20 was amended to rewrite the claim in dependent form, reciting “A vision correction structure including the vision alteration structure of claim 10, the vision correction structure comprising . . .” In an Advisory Action mailed AFTER filing of Appellant’s Brief on Appeal, those amendments were denied entry as “broadening” the scope of the claims. No other amendments to the claims were submitted after the final Office Action mailed June 20, 2003.

SUMMARY OF THE INVENTION

The present invention relates to a scleral prosthesis for implantation into a pocket or tunnel of the sclera of a human in the region of the ciliary muscle to, for example, treat presbyopia by increasing the effective working distance of the ciliary muscle. The prosthesis 100 includes a central body portion 101 and at least one end portion 102 or 103:

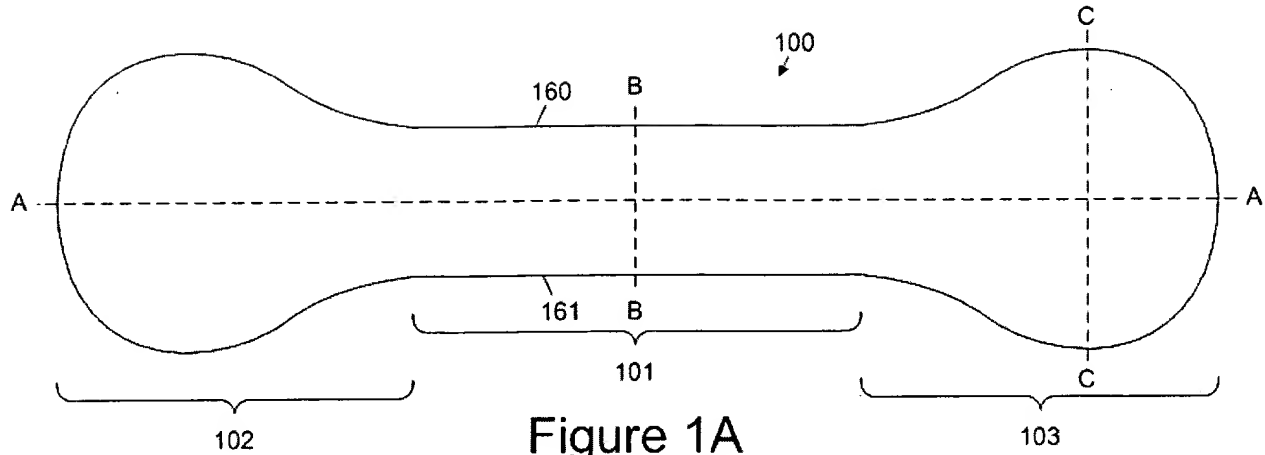


Figure 1A

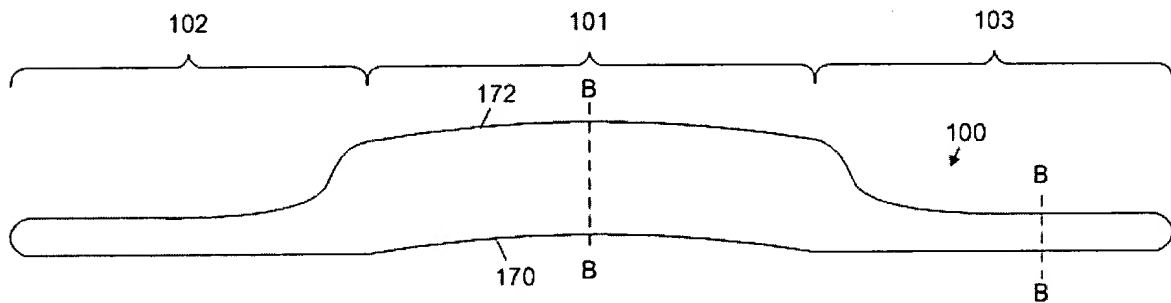
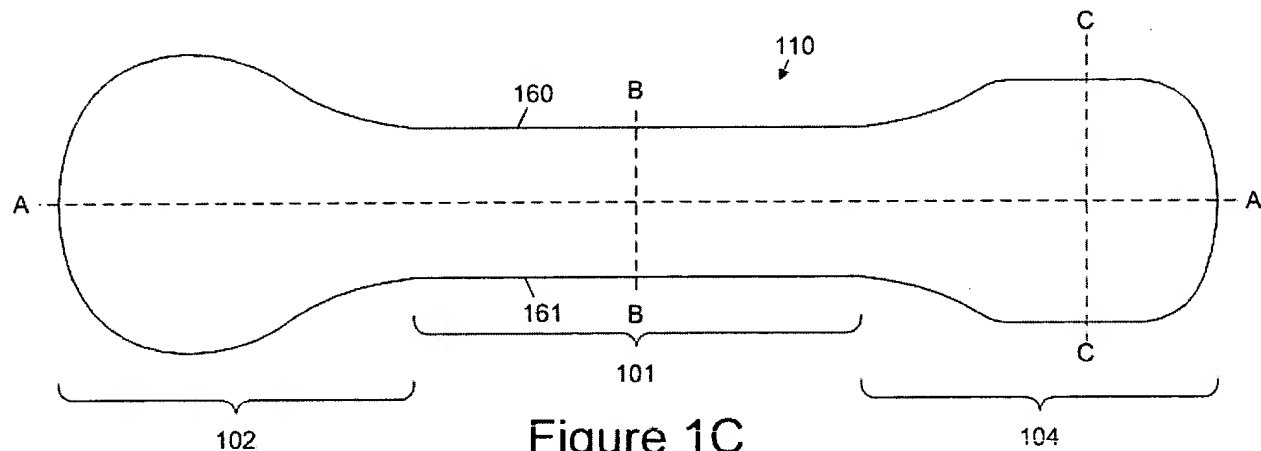


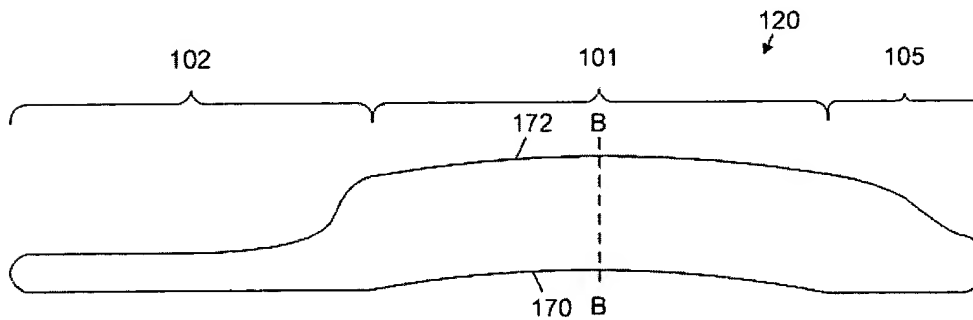
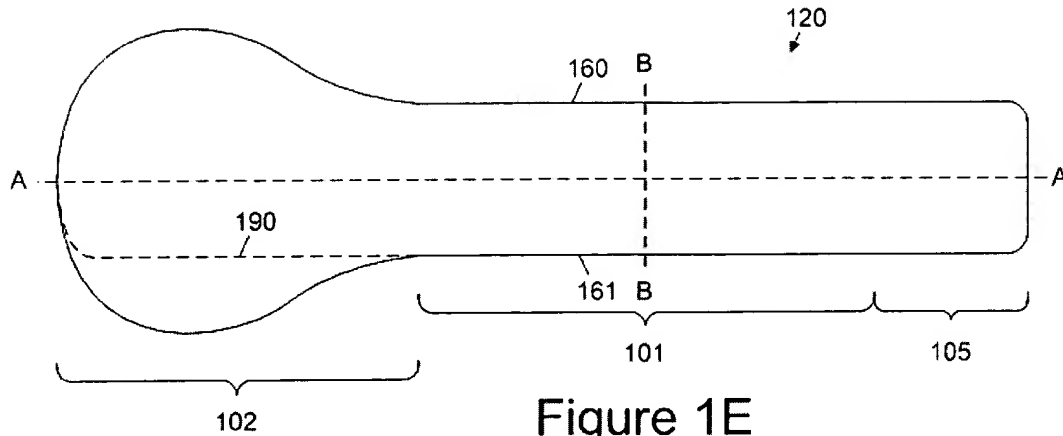
Figure 1B

Specification, Figures 1A–1B; page 14, line 16 through page 15, line 3. The at least one end portion 102 or 103 is wider than the central body portion 101, and also thinner than the central body portion in the exemplary embodiment. Specification, page 15, lines 4–11. In use, the prosthesis 100 is implanted into a surgically formed tunnel (alternative embodiments may be employed within a surgically formed pocket) so that substantially all of the central body portion 101 is within the scleral tunnel while the at least one end portion 102 or 103 rests on the surface of the sclera outside the

tunnel. Specification, page 15, line 12 through page 16, line 3. The curved upper surface 172 contacts and exerts lift on an inner surface of the scleral tunnel or pocket. Specification, page 24, lines 1–6. By elevating the surgically formed “belt-loop” formed in the sclera by the tunnel, the effective working distance of the ciliary muscle is increased and accommodation lost due to presbyopia at least partially restored.

The at least one end portion 102 or 103 resting on the scleral surface outside the tunnel, being wider than the central body portion 101, inhibits rotation of the prosthesis 100 within the scleral tunnel. Specification, page 15, lines 4–11. One end portion 104 of a prosthesis 110 may be narrower than the other 102 to facilitate insertion through the scleral tunnel, or the prosthesis 120 may include a blunted or snubbed end portion 105 for insertion in a scleral pocket or scleral tunnel:





Specification, Figures 1C and 1E–1F, page 16, line 4 through page 18, line 4. In any of the embodiments, the at least one end portion 102 resting on the scleral surface outside the tunnel may be wider than the width of the tunnel into which the prosthesis 100, 110 or 120 is inserted.

In an exemplary embodiment, the prosthesis 100 has a bottom surface 170 that is curved along a long axis of the prosthesis 100. Specification, page 20, line 20 through page 21, line 1. The end portion, however, may have a flat bottom surface from one side to the other:

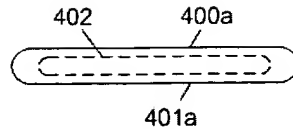


Figure 4A

Specification, Figure 4A, page 27, line 6 through page 28, line 19.

In one embodiment, the prosthesis 130 has a circumferential or arcuate shape to facilitate insertion around a periphery:

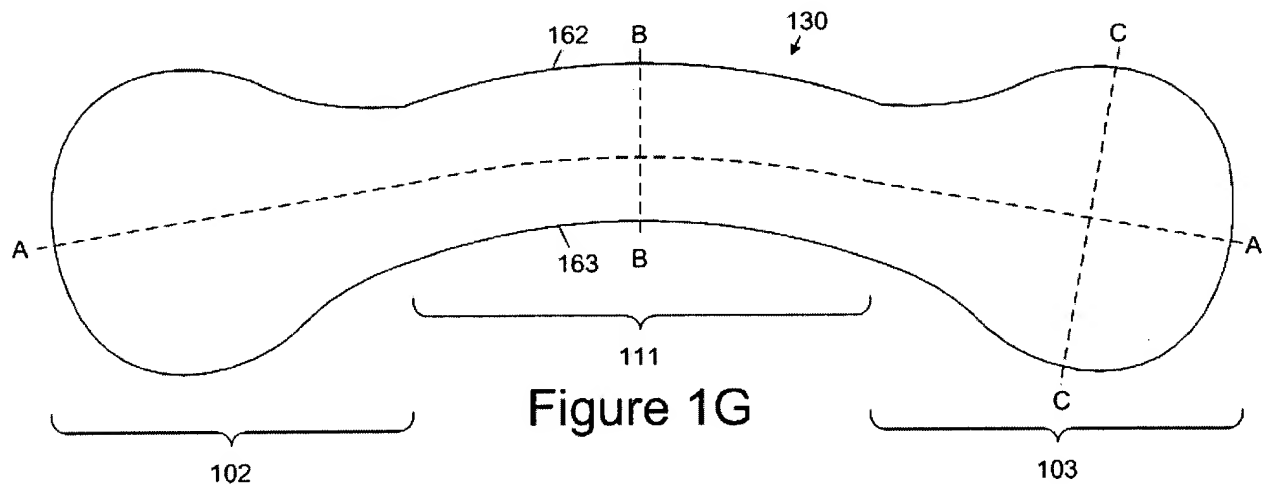


Figure 1G

Specification, Figure 1G, page 18, line 5 through page 19, line 4.

ISSUES ON APPEAL

Claims 1–20 are pending in the present application. Claims 4, 7–9, 12, 16 and 19 have withdrawn from consideration by the Examiner following a restriction requirement, but have not been canceled. Claims 1–3 and 5–6 were rejected under 35 U.S.C. § 102(b) as being anticipated by *Pyson et al.* Claims 10–11, 13–15, 17–18 and 20 were rejected under 35 U.S.C. § 103(a) as being

obvious over *Smith* in view of *Memmen*. The issues on appeal are:

1. whether claims 1–3 and 5–6 were properly rejected under 35 U.S.C. § 102(b) as being anticipated by *Pynson et al*; and

2. whether claims 10–11, 13–15, 17–18 and 20 were rejected under 35 U.S.C. § 103(a) as being obvious over *Smith* in view of *Memmen*.

GROUPING OF CLAIMS

Claims 1–20 are pending in the present application. Claims 4, 7–9, 12, 16 and 19 have withdrawn from consideration by the Examiner following a restriction requirement, but have not been canceled. Claims 1–3 and 5–6 were rejected under 35 U.S.C. § 102(b) as being anticipated by *Pynson et al*. Claims 10–11, 13–15, 17–18 and 20 were rejected under 35 U.S.C. § 103(a) as being obvious over *Smith* in view of *Memmen*. For purposes of this appeal, the pending claims will be grouped together as follows:

Group A – claims 1–3 and 5–6;

Group B – claim 2;

Group C – claim 3;

Group D – claim 5;

Group E – claim 6;

Group F – claims 10–11, 13–15, 17–18 and 20;

Group G – claim 11;

Group H – claim 13–14;

Group I – claim 14;

Group J – claim 15;

Group K – claim 17;

Group L – claim 18; and

Group M – claim 20.

Groups A–M stand or fall independently. Patentability of the claims within each group is argued separately below.

ARGUMENT

Group A (Claims 1–3 and 5–6)

Claims 1–3 and 5–6 of Group A were rejected under 35 U.S.C. § 102(b) as being anticipated by *Pynson et al.* These claims are properly grouped together and considered separately from the claims of Groups B–M since a different grounds of rejection is involved than with the claims of Groups F–M and since a decision with respect to the claims of Group A may obviate the need for consideration of the claims of Groups B–E.

Independent claim 1 of Group A recites that the at least one end portion has a width greater than that of the central body portion. Such a feature is not found in the cited reference. As disclosed in the specification, the central body portion is positioned within the scleral pocket or tunnel when the prosthesis is inserted in the pocket or tunnel, and—as recited in independent claim 1--the end

portion rests outside the pocket or tunnel on the outer surface of the sclera. *Pynson et al* discloses an implant in which the intra-scleral part 1 (the portion implanted under a surgically-created flap) is wider than the sub-conjunctival part 5 (the portion resting on an outer surface of the sclera):

FIG 1

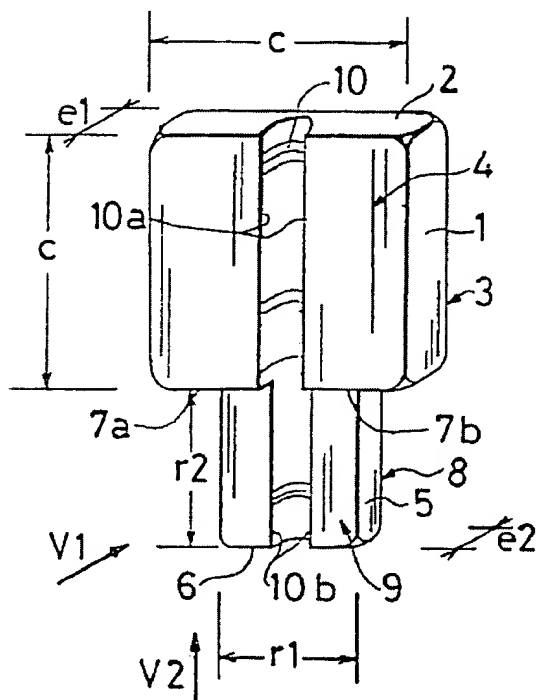


FIG 7

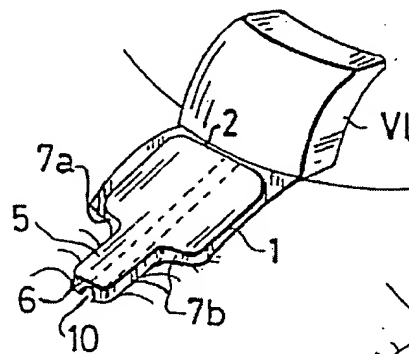
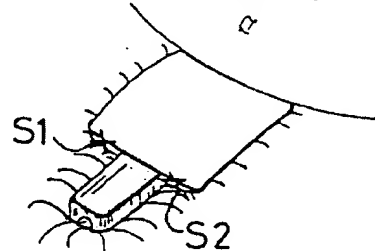


FIG 8



Pynson et al, Figures 1 and 7-8, column 4, lines 28-31, column 5, lines 37-50. Accordingly, the "at least one end portion" (the sub-conjunctival part 5) is not wider than the "central body portion" (the intra-scleral part 1) as recited in independent claim 1.

Independent claim 1 of Group A also recites that the central body portion has a bottom surface which is curved along a long axis of the prosthesis. Such a feature is not found in the cited reference.

Pynson et al discloses an implant with a semi-circular groove along the length, but (a) the entire “central body portion” is not curved as recited in the claim, only the inner surface of the groove, and (b) the curvature is not along the long axis of the prosthesis, but instead is across the long axis of the prosthesis.

Still further, independent claim 1 of Group A recites that the curvature of the bottom surface is greater than a curvature of an innermost surface of a scleral pocket or tunnel into which the prosthesis is to be implanted. Applicants note that this limitation is not a statement of intended use, but a relative definition of a structural feature of the prosthesis. Such a feature is not found in the cited reference.

In addition, independent claim 1 of Group A also recites that the prosthesis is adapted to expand a portion of a sclera proximate to the scleral pocket or tunnel when the prosthesis is inserted within the scleral pocket or tunnel. Applicants note that this limitation is not a statement of intended use, but a description of the structure based on the function to be performed by the structure—that is, the structure is sized, shaped, etc. to expand a portion of the scleral. Such a feature is not found in the cited reference. Contrary to the Office Action, the implant disclosed in *Pynson et al* does not necessarily or inherently cause expansion of the sclera, since *Pynson et al* teaches cutting a flap in the scleral, but depicts that flap as level with surrounding portions of the sclera after being sewn over the intra-scleral part 1 of the implant, with the sub-conjunctival part 5 depressed into the surface of the sclera.

Moreover, independent claim 1 of Group A recites that the end portion inhibits rotation of the prosthesis within the scleral pocket or tunnel. Such a feature is not found in the cited reference.

Group B (Claim 2)

Claim 2 of Group B was rejected under 35 U.S.C. § 102(b) as being anticipated by *Pynson et al.* This claim is properly considered separately from the claims of Groups A and C–M since a different grounds of rejection is involved than with the claims of Groups F–M and since the claim recites a limitation patentably distinguishing the claimed invention over the prior art that is not found in the claims of Groups A and C–E: that the at least one end portion has a width greater than a width of the scleral pocket or tunnel into which the prosthesis is to be implanted.

Claim 2 of Group B recites that the at least one end portion has a width greater than a width of the scleral pocket or tunnel into which the prosthesis is to be implanted. Applicants note that this is not a statement of intended use, but is instead a relative definition of a structural feature of the prosthesis. Such a feature is not found in the cited reference. The “end portion” (sub-conjunctival part 5) of the implant disclosed in *Pynson et al* is narrower than the opening in the sclera receiving the intra-scleral part 1.

Group C (Claim 3)

Claim 3 of Group C was rejected under 35 U.S.C. § 102(b) as being anticipated by *Pynson et al.* This claim is properly considered separately from the claims of Groups A–B and D–M since a different grounds of rejection is involved than with the claims of Groups F–M and since the claim

recites a limitation patentably distinguishing the claimed invention over the prior art that is not found in the claims of Groups A–B and D–E: that the prosthesis body tapers steeply from a thickness of the central body portion to a thickness of the at least one end portion where the end portion joins the central body portion.

Claim 3 of Group C recites that the prosthesis body tapers steeply from a thickness of the central body portion to a thickness of the at least one end portion where the end portion joins the central body portion. Such a feature is not found in the cited reference. *Pynson et al* depicts only an implant having a stepped, not tapered (steeply or otherwise), interface region between the intra-scleral portion 1 and the sub-conjunctival portion 5.

Group D (Claim 5)

Claim 5 of Group D was rejected under 35 U.S.C. § 102(b) as being anticipated by *Pynson et al*. This claim is properly considered separately from the claims of Groups A–C and E–M since a different grounds of rejection is involved than with the claims of Groups F–M and since the claim recites a limitation patentably distinguishing the claimed invention over the prior art that is not found in the claims of Groups A–C and E: that the prosthesis has an overall arcuate shape.

Claim 5 of Group D recites that the prosthesis has an overall arcuate shape, as depicted in Figure 1G of the application. Such a feature is not found in the cited reference.

Group E (Claim 6)

Claim 6 of Group E was rejected under 35 U.S.C. § 102(b) as being anticipated by *Pynson*

et al. This claim is properly considered separately from the claims of Groups A–D and F–M since a different grounds of rejection is involved than with the claims of Groups F–M and since the claim recites a limitation patentably distinguishing the claimed invention over the prior art that is not found in the claims of Groups A–D: that the prosthesis includes a tapered end portion opposite the at least one end portion.

Claim 6 of Group E recites that the prosthesis includes a tapered end portion opposite the at least one end portion, as in the embodiment depicted in Figures 1E and 1F of the application, for insertion into a scleral pocket (rather than a scleral tunnel). Such a feature is not found in the cited reference.

Group F (Claims 10–11, 13–15, 17–18 and 20)

Claims 10–11, 13–15, 17–18 and 20 of Group F were rejected under 35 U.S.C. § 103(a) as being obvious over *Smith* in view of *Memmen*. These claims are properly grouped together and considered separately from the claims of Groups A–E and G–M since a different grounds of rejection is involved than with the claims of Groups A–E and since a decision with respect to the claims of Group F may obviate the need for consideration of the claims of Groups G–M.

Independent claim 10 of Group F recites that the at least one end portion of the prosthesis body is wider and thinner than the central portion of the prosthesis body. Such a feature is not found in the cited references. *Smith* depicts and describes an implant having a porous body with a U-shaped flange around a portion of a periphery, either at the same level. However, *Smith* does not

specify that the flange is wider than the body, but instead specifies that the flange is 2 mm in width while the body is 3 mm in width. *Smith*, column 4, line 15 and column 5, line 4. While the distance from one edge of the U to the other is greater than the width of the body, the flange is not wider than the body. *Memmen* discloses a structure in which anchoring heads 33 and 43 are at least as thick as the neck portions 31 and 41.

Independent claim 10 of Group F also recites that the central portion has at least one curved surface for contacting an inner surface of the scleral pocket or tunnel into which the prosthesis is to be implanted—that is, curved “top” and/or “bottom” surface(s). Applicants note that this is not a statement of intended use, but rather relative identification of a structural element (i.e., a surface of the central portion that will contact an inner surface of the scleral pocket). Such a feature is not found in the cited references. *Smith* discloses only flat surface. *Memmen* similarly discloses a structure having only flat surfaces (see Figure 2), although the entire structure is deformed into an arc upon being affixed to an eye.

Still further, independent claim 10 of Group F recites that the prosthesis expands a portion of a sclera proximate to the scleral pocket or tunnel into which the prosthesis is inserted. Such a feature is not found in the cited references. *Smith* does not depict or describe such expansion of the sclera, nor is such expansion necessary or inherent given that *Smith* teaches excising a block of the sclera in the opening where the device is to be implanted. *Smith*, column 4, lines 17–30. Wings 30 and 40 in the structure disclosed in *Memmen* are placed under extraocular muscles, not inserted in

scleral pockets or tunnels. *Memmen*, column 8, lines 64–66.

Group G (Claim 11)

Claim 11 of Group G was rejected under 35 U.S.C. § 103(a) as being obvious over *Smith* in view of *Memmen*. This claim is properly considered separately from the claims of Groups A–F and H–M since a different grounds of rejection is involved than with the claims of Groups A–E and since the claim recites a limitation patentably distinguishing the claimed invention over the prior art that is not found in the claims of Groups F and G–M: that the at least one end portion rests on a surface of the sclera outside the scleral pocket or tunnel when the prosthesis is inserted within the scleral pocket or tunnel.

Claim 11 of Group G recites that the at least one end portion rests on a surface of the sclera outside the scleral pocket or tunnel when the prosthesis is inserted within the scleral pocket or tunnel. Such a feature is not found in the cited references. *Smith* discloses implantation of the device entirely within the sclera. *Memmen* discloses a device resting entirely on top of the sclera, with portion extending under extraocular muscles but no portion within a scleral pocket or tunnel.

Group H (Claims 13–14)

Claims 13–14 of Group H were rejected under 35 U.S.C. § 103(a) as being obvious over *Smith* in view of *Memmen*. This claim are properly grouped together and considered separately from the claims of Groups A–G and I–M since a different grounds of rejection is involved than with the claims of Groups A–E and since the claims recite a limitation patentably distinguishing the claimed

invention over the prior art that is not found in the claims of Groups F–G and I–M: that the at least one end portion is wider than the scleral pocket or tunnel into which the prosthesis is inserted.

Claim 13 of Group H recites that the at least one end portion is wider than the scleral pocket or tunnel into which the prosthesis is inserted. Such a feature is not found in the cited reference. As noted above, the entire device is implanted in *Smith*, while *Memmen* does not teach implantation into the sclera.

Group I (Claim 14)

Claim 14 of Group I was rejected under 35 U.S.C. § 103(a) as being obvious over *Smith* in view of *Memmen*. This claim is properly considered separately from the claims of Groups A–H and J–M since a different grounds of rejection is involved than with the claims of Groups A–E and since the claim recites a limitation patentably distinguishing the claimed invention over the prior art that is not found in the claims of Groups F–H and J–M: that the at least one end portion is sized to pass through the scleral tunnel as the prosthesis is inserted into the scleral tunnel.

Claim 14 of Group I recites that the at least one end portion is sized to pass through the scleral tunnel as the prosthesis is inserted into the scleral tunnel. Such a feature is not found in the cited references. *Smith* teaches implantation into an excised hole under a scleral flap, not through a tunnel. *Memmen* does not teach implantation into the sclera at all.

Group J (Claim 15)

Claim 15 of Group J was rejected under 35 U.S.C. § 103(a) as being obvious over *Smith* in

view of *Memmen*. This claim is properly considered separately from the claims of Groups A–I and K–M since a different grounds of rejection is involved than with the claims of Groups A–E and since the claim recites a limitation patentably distinguishing the claimed invention over the prior art that is not found in the claims of Groups F–I and K–M: that the prosthesis tapers steeply in a region where the central portion and the at least one end portion join, from a thickness of the central portion to a smaller thickness of the at least one end portion.

Claim 15 of Group J recites that the prosthesis tapers steeply in a region where the central portion and the at least one end portion join, from a thickness of the central portion to a smaller thickness of the at least one end portion. Such a feature is not found in the cited references. Neither *Smith* nor *Memmen* teach any taper, but instead only depict stepped joiner regions.

Group K (Claim 17)

Claim 17 of Group K was rejected under 35 U.S.C. § 103(a) as being obvious over *Smith* in view of *Memmen*. This claim is properly considered separately from the claims of Groups A–J and L–M since a different grounds of rejection is involved than with the claims of Groups A–E and since the claim recites a limitation patentably distinguishing the claimed invention over the prior art that is not found in the claims of Groups F–J and L–M: that the prosthesis has an overall arcuate or angled shape.

Claim 17 of Group K recites that the prosthesis has an overall arcuate or angled shape, as in the embodiment depicted in Figure 1G. Such a feature is not found in the cited references. *Smith*

does not disclose any arcuate shape, while *Memmen* discloses a flat structure deformed into a circumferential shape when affixed to the surface of an eye.

Group L (Claim 18)

Claim 18 of Group L was rejected under 35 U.S.C. § 103(a) as being obvious over *Smith* in view of *Memmen*. This claim is properly considered separately from the claims of Groups A–K and M since a different grounds of rejection is involved than with the claims of Groups A–E and since the claim recites a limitation patentably distinguishing the claimed invention over the prior art that is not found in the claims of Groups F–K and M: a tapered end portion on the central body portion opposite the at least one end portion.

Claim 18 of Group L recites a tapered end portion on the central body portion opposite the at least one end portion, as in the embodiment depicted in Figures 1E and 1F in the application. Such a feature is not found in the cited references.

Group M (Claim 20)

Claim 20 of Group M was rejected under 35 U.S.C. § 103(a) as being obvious over *Smith* in view of *Memmen*. This claim is properly considered separately from the claims of Groups A–L since a different grounds of rejection is involved than with the claims of Groups A–E and since the claim recites a limitation patentably distinguishing the claimed invention over the prior art that is not found in the claims of Groups F–L: a plurality of prostheses having the recited structure within equidistantly spaced scleral pockets or tunnels around a cornea of an eye.

Claim 20 of Group M recites a plurality of prostheses having the recited structure within equidistantly spaced scleral pockets or tunnels around a cornea of an eye. Such a feature is not found in the cited references.

CONCLUSION

The cited references fail to depict or describe all features of the invention claimed in Groups A-M. Therefore, the rejections under 35 U.S.C. §§ 102 and 103 are improper. Applicants respectfully requests that the Board of Appeals reverse the decisions of the Examiner below rejecting pending claims 1-3, 5-6, 10-11, 13-15, 17-18 and 20 in the application.

Respectfully submitted,

DAVIS MUNCK, P.C.

Date: Feb. 3, 2005



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**APPENDIX TO SUBSTITUTE APPELLANTS' BRIEF ON APPEAL
PENDING CLAIMS ON APPEAL**

1 1. A prosthesis adapted for contact with the sclera of an eyeball, said prosthesis
2 comprising:
3 a central body portion having a first end and a second end, at least one end portion
4 extending from either said first or second end of said central body portion, said at least one end
5 portion having a width greater than said central body portion,
6 said central body portion having a bottom surface which is curved along a long axis
7 of said prosthesis,
8 wherein a curvature of said bottom surface is greater than a curvature of an innermost
9 surface of a scleral pocket or tunnel into which said prosthesis is to be implanted,
10 wherein said prosthesis is adapted to expand a portion of a sclera proximate to the
11 scleral pocket or tunnel when said prosthesis is inserted within said scleral pocket or tunnel, and
12 wherein said end portion is adapted to rest on a portion of said sclera outside said
13 scleral pocket or tunnel when said prosthesis is inserted within said scleral pocket or tunnel and to
14 inhibit rotation of said prosthesis within said scleral pocket or tunnel.

1 2. The prosthesis according to claim 1, wherein said at least one end portion has a width
2 greater than a width of said scleral pocket or tunnel into which said prosthesis is to be implanted.

1 3. The prosthesis according to claim 1, wherein said central body portion tapers steeply
2 from a thickness of said central body portion to a thickness of said at least one end portion within
3 a region where said at least one end portion joins said central body portion.

1 4. The prosthesis according to claim 1, wherein said at least one end portion has a flat
2 bottom surface.

1 5. The prosthesis according to claim 1, wherein said prosthesis has an overall arcuate
2 shape.

1 6. The prosthesis according to claim 1, further comprising:
2 a tapered end portion extending from one of said first or second ends opposite another
3 of said first and second ends from which said at least one end portion extends.

1 7. The prosthesis according to claim 1, further comprising:
2 at least one groove within a surface of an end portion extending from one of said first
3 or second ends opposite another of said first and second ends from which said at least one end
4 portion extends.

1 8. A vision correction structure, comprising:
2 a plurality of arcuate prostheses positioned within scleral pockets or tunnels around
3 a cornea of an eye.

1 9. The vision correction structure according to claim 8, wherein said plurality of arcuate
2 prostheses are equidistantly spaced.

1 10. A vision alteration structure, comprising:
2 at least one prosthesis for insertion into a pocket or tunnel within a sclera for an eye,
3 comprising:
4 a body having a central portion and at least one end portion integrally formed
5 with and extending from an end of said central portion, said at least one end portion being
6 wider and thinner than said central portion,
7 said central portion having at least one curved surface for contacting an inner
8 surface of said scleral pocket or tunnel into which said prosthesis is to be implanted,
9 wherein said prosthesis is adapted to expand a portion of a sclera proximate
10 to said scleral pocket or tunnel when said prosthesis is inserted within said scleral pocket or
11 tunnel.

1 11. The vision alteration structure according to claim 10, wherein said at least one end
2 portion rests on a surface of said sclera outside said scleral pocket or tunnel when said prosthesis is
3 inserted within said scleral pocket or tunnel.

1 12. The vision alteration structure according to claim 10, wherein said at least one end
2 portion further comprises:

3 two end portions integrally formed with and extending from opposing ends of said
4 central portion, each end portion wider and thinner than said central portion and resting on a surface
5 of said sclera outside said scleral tunnel when said prosthesis is inserted within said scleral tunnel.

1 13. The vision alteration structure according to claim 10, wherein said at least one end
2 portion is wider than said scleral pocket or tunnel when said prosthesis is inserted within said scleral
3 tunnel.

1 14. The vision alteration structure according to claim 13, wherein said at least one end
2 portion is sized to pass through said scleral tunnel as said prosthesis is inserted into said scleral
3 tunnel.

1 15. The vision alteration structure according to claim 10, wherein a portion of said
2 prosthesis including a region where said central portion as said at least one end portion join tapers
3 steeply from a thickness of said central portion to a smaller thickness of said at least one end portion.

1 16. The vision alteration structure according to claim 10, wherein said at least one end
2 portion has a bottom surface including a flat region.

1 17. The vision alteration structure according to claim 10, wherein said at least one
2 prosthesis has an overall arcuate or angled shape.

1 18. The vision alteration structure according to claim 10, further comprising:
2 a tapered end portion integrally formed with and extending from an end of said central
3 portion opposite said at least one end portion.

1 19. The vision alteration structure according to claim 10, further comprising:
2 at least one position retaining groove within a surface of an end portion integrally
3 formed with and extending from an end of said central portion opposite said at least one end portion.

1 20. A vision correction structure, comprising:
2 a plurality of additional prostheses each having a structure of said at least one
3 prosthesis, said plurality of additional prostheses and said at least one prosthesis positioned within
4 equidistantly spaced scleral pockets or tunnels around a cornea of an eye.

DOCKET NO. PRES06-00208

PATENT

Customer No. 23990

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re application of : GENE W. ZDENEK ET AL
U.S. Serial No. : 09/863,006
Filed : May 22, 2001
For : SCLERAL EXPANSION DEVICE HAVING DUCK BILL
Group No. : 3738
Examiner : William H. Matthews

MAIL STOP APPEAL BRIEF - PATENTS

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Sir:

RESPONSE TO NOTIFICATION OF NON-COMPLIANCE WITH 37 CFR 1.192(c)

In response to the Notification of Non-Compliance with 37 CFR 1.192(c) mailed January 3, 2005 ("Notice"), Applicant notes:

The Notice asserts that at least one amendment has been filed subsequent to the final rejection, and the brief does not contain a statement of the status of each such amendment. However, the subject amendment (to claims 3, 15 and 20) was submitted concurrently with Appellant's Brief on Appeal, which stated:

An amendment to claims 3, 15 and 20 is being submitted herewith for clarity, to correct typographical and grammatical errors therein. No other amendments to the claims were submitted after the final Office Action mailed June 20, 2003.

Appellant's Brief on Appeal, page 2. An Advisory Action mailed AFTER filing of Appellant's Brief on Appeal denied entry of those claim amendments as "broadening" the scope of the claims. Paper No. 20040304. Accordingly, the statement as to the status of amendments with Appellant's Brief on Appeal was accurate at the time of filing of Appellant's Brief on Appeal. Further, Applicant respectfully notes that the subsequent change in the status of those amendments could easily have been noted in an Examiner's Answer.

Nonetheless, Applicant is submitting the attached Substitute Appellant's Brief on Appeal containing a statement of the current status of amendments to the claims filed subsequent to the final rejection.

The Notice asserts that the brief does not contain a correct copy of the appealed claims as an appendix thereto. However, the appendix to Appellant's Brief on Appeal contains the claims as pending prior to the final Office Action mailed June 20, 2003, without the claim amendments submitted concurrently with Appellant's Brief on Appeal. Since those amendments were DENIED ENTRY, the claims within the appendix to Appellant's Brief on Appeal are, in fact, CORRECT.

If any issues arise, or if the Examiner has any suggestions for expediting allowance of this Application, the Applicant respectfully invites the Examiner to contact the undersigned at the telephone number indicated below or at *wmunck@davismunck.com*.

The Commissioner is hereby authorized to charge any additional fees connected with this communication or credit any overpayment to Deposit Account No. 50-0208.

Respectfully submitted,

DAVIS MUNCK, P.C.

Date: Feb 3, 2005



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